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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,866	12/08/2003	Takeshi Makiyama	1152-0295P	1179

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EXAMINER

SHERALI, ISHRAT I

ART UNIT PAPER NUMBER

2621

DATE MAILED: 09/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/728,866	Applicant(s) MAKIYAMA ET AL.	
	Examiner Sherali Ishrat	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 20 and 21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12082003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/727,787.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12082003</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37CFR 1.83 (a). The drawings must show every feature of the invention specified in claims. The claim 21 in line 1, recites "A propagated signal embodied in a carrier". Drawings do not illustrate this feature.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 20 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20 and 22 of copending application no. 10/729158. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim 20 of the instant application is broader than claims 20 and 22 of copending application no. 10/729158.

Regarding claim 20 of instant application and claim 20 of copending application no. 10/729158, claims recite:

storing previously defined tools (claim 20 of instant application, line 2) which is same as storing a coding algorithm for coding image data and the tools constituting the algorithm (claim 20 of copending application no. 10/729158, lines 2-3);

individually selecting at least one tool from the stored tools (claim 20 of instant application, lines 3-4) which is same as at least one tool for constituting the decoding algorithm is selected individually (claim 20 of copending application no. 10/729158, lines 9-10);

inputting image data and coding the image data using stored coding algorithm (claim 20 of instant application, lines 5-6) which is same as inputting image data and coding the image data using stored coding algorithm (claim 20 of copending application no. 10/729158, lines 6-7);

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transmitting coded image data and tool information indicating the decoding algorithm for decoding the coded image data (claim 20 of instant application, lines 7-9) which is same outputting coded image data and tool information indicating the decoding algorithm for decoding the coded image data (claim 20 of copending application no. 10/729158, lines 8-9).

Regarding claim 20 of instant application and claim 22 of copending application no. 10/729158, claims recite:

storing previously defined tools (claim 20 of instant application, line 2) which is same as storing previously defined tools (claim 22 of copending application no. 10/729158, line 3);

individually selecting at least one tool from the stored tools (claim 20 of instant application, lines 3-4) which is same as individually selecting at least one tool from the previously defined tools (claim 22 of copending application no. 10/729158, lines 4-5);

inputting image data and coding the image data using stored coding algorithm (claim 20 of instant application, lines 5-6) which is same as inputting image data and coding the image data by applying coding algorithm (claim 22 of copending application no. 10/729158, line 2 and lines 7-8);

transmitting coded image data and tool information indicating the decoding algorithm for decoding the coded image data (claim 20 of instant application, lines 7-9) which is as transmitting coded image data and tool information indicating the decoding algorithm for decoding the coded image data (claim 22 of copending application no. 10/729158, lines 9-11);

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claim 20 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,310,981 in view of Yagizawa et al. (JP Kokai Patent Application No. Hei 4 [1992]-8064).

Regarding claim 20 of instant application and claim 9 of U.S. Patent 6,310,981, claims recite:

storing previously defined tools (claim 20 of instant application, line 2) which is same as storing coding algorithm for coding the image data and multiple tools (U.S. Patent No. 6,310,981, lines 3-4);

inputting image data and coding the image data using stored coding algorithm (claim 20 of instant application, lines 5-6) which is same as encoding the image data using stored coding algorithm (U.S. Patent No. 6,310,981, lines 8-9, image is obviously inputted in the encoder/coder to code the image data);

transmitting coded image data and tool information indicating the decoding algorithm for decoding the coded image data (claim 20 of instant application, lines 7-9) which is same as outputting coded image along with information indicating ranks of tools constituting decoding algorithm (U.S. Patent No. 6,310,981, lines 9-10, image data is obviously transmitted to output device from input device)

U.S. Patent No. 6,310,981 shows selecting multiple tools (U.S. Patent No. 6,310,981, claim 5, lines 9-10). U.S. Patent No. 6,310,981 however have not shown individually selecting at least one tool from the stored tools.

In the same field of endeavor Yagizawa discloses individually selecting at least one tool from the stored tools (Yagizawa in page 5, lines 9-10 and page 5, lines 27-28, states "A coding algorithm storage means configured with multiple RAMS for storing coding table containing coding algorithm for DPCM" and "DPCM table is loaded, can be selected by switching a switch" which corresponds to individually selecting at least one tool from the stored tools).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Regarding claim 21, claim in line 1, recites "A propagated signal embodied in a carrier". The specification say nothing about this feature.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claims 20-21 rejected under 35 U.S.C. 102(b) as being anticipated by Yagizawa et al. (JP Kokai Patent Application No. Hei 4 [1992]-8064).

Regarding claim 20, Yagizawa discloses storing previously defined tools (Yagizawa in page 4, lines 7-8, states "multiple decoding algorithm storage and storing coding algorithms" which corresponds to storing previously defined tools);

individually selecting at least one tool from the stored tools (Yagizawa in page 5, lines 9-10 and page 5, lines 27-28, states "A coding algorithm storage means configured with multiple RAMS for storing coding table containing coding algorithm for DPCM" and "DPCM table is loaded, can be selected by switching a switch" which corresponds to individually selecting at least one tool from the stored tools);

inputting the image data and coding the image data using the stored coding algorithm (Yagizawa in page 5, lines 22-23, states "the DPCM table [coding algorithm for DPCM mentioned above] is loaded first is for the image data that is transmitted first" which corresponds to inputting the image data and coding the image data using the stored coding algorithm).

transmitting coded image data and tool information indicating the decoding algorithm for decoding the coded image data (Yagizawa in page 4, lines 15-20, states "the information transmission means is a means for dividing a required decoding table corresponding to the coding table into separate sync blocks and further adding an identification code before transmission" corresponds to transmitting coded image data and tool information indicating the decoding algorithm for decoding the coded image data).

Regarding claim 21, Yagizawa discloses a first code segment including compressed image data (Yagizawa in page 5, lines 15-20, states "divide coding table into scatted sync blocks and adds an identification code for transmission and add an identification code for transmission" dividing coding table into sync blocks corresponds to a first code segment including compressed image data);

a second code segment including tool information which indicates tools for constituting decoding algorithm for decoding the compressed image data (Yagizawa in page 5, lines 15-20, states "divide coding table into scatted sync blocks and adds an identification code for transmission represents a decoding algorithm decision means to decide decoding algorithm which serves as a means to decide decoding algorithm" adding an identification code for transmission represents a decoding algorithm decision means to decide decoding algorithm which serves as a means to decide decoding algorithm corresponds to a second code segment including tool information which indicates tools for constituting decoding algorithm for decoding the compressed image data),

at least one tool for constituting the decoding algorithm is selected individually (Yagizawa, in page 5, lines 18-20 states "a decoding algorithm decision means which serves a as means to decide the decoding algorithm, means is used to detect identification code in order to identify decoding table" which corresponds to at least one tool [decoding table] for constituting the decoding algorithm is selected individually).

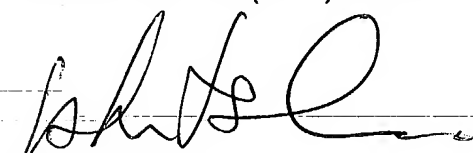
Contact Information

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sherali Ishrat whose telephone number is 703-308-9589. The examiner can normally be reached on 8:00 AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Boudreau can be reached on 703-305-4706. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

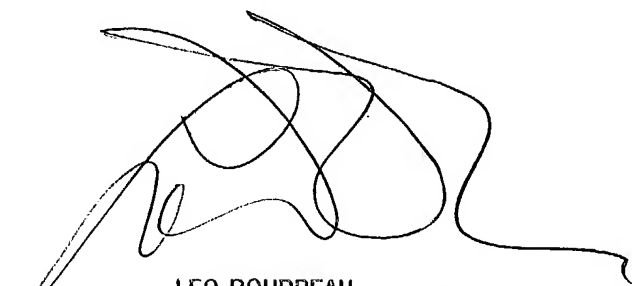


Ishrat Sherali

Patent Examiner

Group Art Unit 2621

September 2, 2004



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